

Docket No. 700624-2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: Yuri V. Melnick, *et al.*

App. No: 09/903,047

Filed: July 11, 2001

Status: Issue Fee Paid

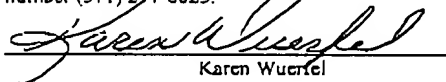
Title: Method for Achieving Low Defect
Density AlGaIn Single Crystal Boules

Group Art Unit: 1765

Examiner: Felisa C. Hiteshew

Certificate of Mailing Under
37 C.F.R. § 1.8

Date of Deposit: March 29, 2005

I hereby certify that this correspondence and all attachments are being
transmitted via facsimile to Office of Petitions, Commissioner for
Patents, PO Box 1450, Alexandria, Virginia 22313-1450, to facsimile
number (571) 277-0025.
Karen WuerfelPETITION TO WITHDRAWAL APPLICATION
FROM ISSUE UNDER 37 CFR 1.313(c)

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX RECEIVED

MAR 29 2005

Sir:

OFFICE OF PETITIONS

1. DOCUMENTS ENCLOSED:

- ☒ Petition for Express Abandonment Transmittal (Attachment A).
- ☒ Express Abandonment Under 37 CFR 1.138 (PTO/SB/24) (Attachment B).
- ☒ Authorization By Assignee For Petition For Express Abandonment of
Application (Attachment C).
- ☒ Assignment Record of Subject Application (Attachment D).
- ☒ Terminal Disclaimer Filed in Subject Application No. 09/903,047
(Attachment E).
- ☒ Assignment Record of Application No. 09/901,926, now U.S. Patent No.
6,576,054 (Attachment F).
- ☒ Assignment Record of Patent No. 6,261,363 (Attachment G).
- ☒ Assignment Record of Application No. 09/849,771, now U.S. Patent No.
6,562,131 (Attachment H).

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- ☒ Terminal Disclaimer Filed in Application No. 09/901,926, now U.S. Patent No. 6,576,054. (Attachment I).
- ☒ Continuation Application (Attachment J).
- ☒ Terminal Disclaimer for Continuation Application (Attachment K).

2. **WITHDRAWAL IN FAVOR OF CONTINUATION APPLICATION.**

In accordance with 37 CFR 1.313(c)(3), Applicants expressly abandon Application No. 09/903,047 in favor of a continuation application filed herewith (Attachment J). The filing of the continuation application is not conditional on the granting of the instant petition.

3. **GOOD AND SUFFICIENT REASONS WHY WITHDRAWAL FROM ISSUE IS NECESSARY.**

In accordance with 37 CFR §§1.313(a) and (c), Applicants respectfully submit that there are good and sufficient reasons why the above-identified application should be withdrawn from issue based on the terminal disclaimer that was filed in the application.

A. **Background - Pending Application No. 09/903,047.**

The subject application is assigned to **Technologies and Devices International, Inc.** ("TDII"), as reflected in the assignment recorded at Reel / Frame 012268 / 0388. (Attachment D).

Paragraph 3 of the December 5, 2002 Office action included a provisional rejection of certain claims under the doctrine of obviousness-type double patenting, based on Application No. **09/901,926**, which issued as U.S. Patent No. 6,576,054.

With their January 6, 2003 Response/Amendment, Applicants filed a Terminal Disclaimer, a copy of which is enclosed as Attachment E. The Terminal Disclaimer refers to Application No. **09/901,926**. In addition, the Terminal Disclaimer refers to U.S. Patent No. 6,261,363 and any patent that would issue from Patent Application No. **09/849,771**.

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B. Ownership of Applications / Patents Identified in Terminal Disclaimers in Subject Application.

Application No. 09/901,926 issued as U.S. Patent No. 6,576,054 and is assigned to **TDII**, as reflected in the assignment recorded at Reel / Frame Number 012268 / 0385. (Attachment F).

U.S. Patent No. 6,261,363 is assigned to **The Fox Group, Inc. ("Fox")**, as reflected in the assignments recorded at Reel / Frame Numbers 013475 / 0067; 013484 / 0366 and 013868 / 0615. (Attachment G).

Application No. 09/849,771 issued as U.S. Patent No. 6,562,131 and is also assigned to **Fox**, as reflected in the assignments recorded at Reel / Frame Numbers 012546 / 0784 and 012834 / 0909. (Attachment H).

Thus, the Terminal Disclaimer (Attachment E) in the subject application refers to applications and patents that were not commonly owned when the terminal disclaimer was filed and are not currently commonly owned.

C. Terminal Disclaimer in Application No. 09/901,926, now U.S. Patent No. 6,576,054.

As discussed above in section A., Paragraph 3 of the December 5, 2002 Office action in the subject application included a provisional rejection of certain claims under the doctrine of obviousness-type double patenting, based on Application No. 09/901,926, now U.S. Patent No. 6,576,054.

During prosecution of Application No. 09/901,926, a provisional obviousness-type rejection was made based on Application No. 09/903,047 (the subject application). Applicants filed a terminal disclaimer. (Attachment I).

The terminal disclaimer (Attachment I) refers to Application No. 09/903,047, the subject application, which is owned by TDII.

The terminal disclaimer (Attachment I) also refers to U.S. Patent No. 6,261,363 and Application No. 09/849,771 (which issued as U.S. Patent No. 6,562,131), both of which were assigned to Fox, as discussed above.

Thus, the Terminal Disclaimer (Attachment E) that was filed in the subject application refers to a patent having a Terminal Disclaimer (Attachment I) that refers to

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applications and patents that were not commonly owned when the Terminal Disclaimer (Attachment I) was filed.

D. Terminal Disclaimer in Subject Application Did Not Have Its Intended Effect; Corrected Terminal Disclaimer.

In view of the forgoing remarks, the Terminal Disclaimer (Attachment E) that was filed in the subject application refers to applications and patents that were not and are not commonly owned, therefore, and did not have its intended effect, particularly considering that the Paragraph 3 of the December 5, 2002 Office action in the subject application sets forth a provisional obviousness-type double patenting rejection based on Application No. 09/901,926.

Applicants submit a terminal disclaimer (Attachment K) with the continuation application (Attachment J). The current terminal disclaimer disclaims the terminal part of the statutory term of any patent granted on the continuation application, which would extend beyond July 6, 2021, which is the date that U.S. Patent No. 6,576,054 would have expired had the terminal disclaimer (Attachment I) based only on Application No. 09/903,047 been filed in Application No. 09/901,926, since both Application No. 09/903,047 (the subject application) and Application No. 09/901,926 (now U.S. Patent No. 6,526,054) claim priority to the same parent Application No. 09/900,833, filed July 6, 2001.

The patent term for the continuation application, therefore, is calculated as 20 years from the earliest effective filing date. In this instance, the earliest effective filing date is July 6, 2001, and 20 years from July 6, 2001 is July 6, 2021. Thus, by the current terminal disclaimer, the term of a patent issuing from the continuation application would not extend beyond that which is allowed under patent term calculations based on 20 years from the earliest effective filing date. In the event that a patent issuing from the continuation application would be subject to a patent term extension, the current terminal disclaimer disclaims any and all such extension.

Applicants respectfully submit that the forgoing remarks provide good and sufficient reasons why the subject application should be withdrawn from issue in favor of a continuation application (Attachment J) and the current terminal disclaimer (Attachment K).

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4. PETITION FEE:

- ☒ The Commissioner is hereby authorized to charge to Bingham McCutchen's Deposit Account No. **50-2518** the fee of **\$130.00** for this petition, as set forth in 37 CFR § 1.17(h), docket number 700624-2001.
- ☒ The Commissioner is authorized to charge Bingham McCutchen's Deposit Account No. **50-2518** for any fees required that are not covered, in whole or in part, by a check enclosed herewith and to credit any overpayments to said Deposit Account No. **50-2518**, docket number 700624-2001.

Respectfully submitted,

BINGHAM McCUTCHEN LLP

Dated: March 29, 2005

By: 

Gary D. Lueck

Reg. No. 50,791

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